

REMARKS

This paper is filed in response to the Office Action dated March 1, 2004 and the Office Action of November 19, 2004. Because applicants filed a *bona fide* reply accompanied by a request and corresponding fee for a one-month extension on July 1, 2004 and file this paper on December 17, 2004, this response is timely made.

I. Status of Amendments

Claims 1-85 were pending prior to this amendment, considering that applicant's July 1 amendment was not entered by the examiner. By this amendment, applicant cancels claims 1-85 without prejudice to refile, and adds new claims 86-96. Thus, claims 86-96 are now pending.

Because applicant previously paid fees for 4 independent and 85 total claims, applicant's amendments require no further fees.

II. Response to Office Action

A. General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.¹ For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus,

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘_____’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

B. The November 19 Office Action

In the November 19 Office Action, it was suggested that the claims presented in the July 1 amendment were directed to an invention that is independent or distinct from the invention originally claimed. Specifically, it was noted that the claims recited wagering and failed to recite a bonus game. Applicants have removed any reference to wagering in the

claims, and have amended the claims to recite a bonus game. Thus, the amendment should now be responsive.

C. The March 1 Office Action

The drawings were objected to for line weight and lettering in Figs. 4 and 5 and a lack of explanatory text in Fig. 6. Figs. 4-6 have been amended accordingly. Thus, applicants request that the objection to the drawings be withdrawn.

The specification, more specifically the abstract and the title, was objected to for various reasons. The abstract and the title have been amended accordingly. Thus, applicants request that the objections to the specification be withdrawn.

Claim 11 was objected to as allegedly missing the word “spaces.” As claim 11 has been canceled, the objection is moot.

Further, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Colin et al. (U.S. Patent No. 6,346,043) and claims 2-38 as being unpatentable over Colin et al. in view of one or more of Mirando (U.S. Patent No. 5,411,271), Baerlocher et al. (U.S. Patent No. 6,669,559), and Bennett (U.S. Patent No. 6,572,471). As claims 1-38 have been cancelled, without prejudice to refile, these rejections are moot. However, given the reliance placed on Colin, Mirando, Baerlocher, and Bennett, applicants have the following comments.

Claim 86 recites a gaming method including displaying an image representing a game. The gaming method also includes determining if an event has occurred, and displaying an array, as a part of a bonus game, including a plurality of spaces if the event has occurred, each of the plurality of spaces having an indicium associated therewith that matches with at least one other indicium associated with another of the plurality of spaces. The gaming method further includes revealing the indicia associated with the plurality of space for a period of time when a requirement occurs during the game, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level and concealing the indicia associated with the plurality of space after revealing the indicia for the period of time. The method further includes receiving a first selection of one of the plurality of spaces after revealing the indicia for the period of time, revealing the indicium associated with the one of the plurality of spaces, receiving a second selection of

another of the plurality of spaces, revealing the indicium associated with the another of the plurality of space, determining if the indicia associated with the one and the another of the plurality of spaces match, and providing an award if the indicia associated with the one and the another of the plurality of spaces match.

In particular, claim 86 recites revealing the indicia of the plurality of spaces for a period of time when a requirement occurs during the game, the requirement comprising one of matching certain indicia, revealing a specified indicium, and reaching an achievement level, concealing the indicia of the plurality of spaces after revealing the indicia of the plurality of spaces for the period of time, and receiving a first selection of one of the plurality of spaces after revealing the indicia of the plurality of spaces. Applicants respectfully submit that Colin et al., Mirando, Baerlocher et al. and Bennett, whether taken individually or in combination, do not disclose teach or suggest these limitations.

In regard to Colin et al., Colin et al. expressly states that the indicia associated with the boxes are revealed as they are selected by the player. Col. 3:41-46 (“For example, if the player selects the player-selectable area or box at row 1, column 4 of the play area by touching the screen within this area, the image and award previously assigned to this area will be displayed within the box as shown in FIG. 4 and described in step 3 of FIG. 1.”). Once a group is completed, then all the indicia are shown to the player. Col. 3:66 – Col 4:1 (“As shown in FIG. 7 and described in step 7 of FIG. 1, the images and awards assigned to any unselected boxes are revealed. “). Colin et al. also expressly states that FIG. 2 is not disclosed to the player, but is for illustrative purposes only. Col. 3:2-4 (“Although an example of such an assignment is illustrated in FIG. 2, the assignment of the images and awards is not disclosed to the player.”). Thus, Colin et al. does not disclose, teach or suggest the limitations particularly recited above; in fact, Colin et al. appears to teach away from the claimed subject matter in this regard.

In regard to Mirando, while Mirando discloses a matching game wherein some or all of the game pieces are disclosed before the player selects one of the game pieces (Col.5:9-14 (“In a first mode all curtains raise and lower at once; in a second mode only three windows are uncovered at one time; and, in a third mode, the machine randomly decides to uncover two windows at a time, or three windows at a time, or all windows at once.”))), the time the curtains are raised is not tied to performance of the player in some prior event. In this regard, while Mirando discusses a timer, the timer referred to controls game time, not the amount of

time the curtains are raised. Col. 5:14-17 ("Perhaps the most important feature of the game 10 is the "Timer" which allows the operator to change the game time from 20 to 60 seconds in 5 second intervals."). Thus, Mirando does not provide the disclosure, teaching or suggestion missing from Colin et al.

As for the references to Baerlocher et al. and Bennett, neither of these patents provides the missing disclosure, teachings and suggestions in regard to the particularly cited limitations above. Consequently, these patents, whether taken individually or in combination with Colin et al. and/or Mirando, do not disclose, teach or suggest each and every limitation of the claimed subject matter.

Therefore, claim 86 is allowable. Given that claims 87-96 depend from claim 86 and that claim 86 is distinguishable over Colin et al., Mirando, Baerlocher et al., and Bennett, so too are claims 87-96.

In summary, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested.

D. The Supplemental Information Disclosure Statement

Enclosed with the July 1 Amendment was a Supplemental Information Disclosure Statement in regard to the above-mentioned application.

By the Supplemental Information Disclosure Statement, applicants cite U.S. Patent Application No. 10/029,384 ("the '384 application"), U.S. Published Application No. 2003/0114220, which is the published version of the '384 application, and U.S. Patent No. 6,746,328, ("the '328 patent") which corresponds to the 'U.S. Patent Application 10/151,556 application. Further, applicants cite those documents not previously cited to or by the U.S. Patent and Trademark Office in the above-mentioned application that were cited to or by the U.S. Patent and Trademark Office during the prosecution of the '384 application and the '328 patent.

Additionally, the named inventor of the '384 application is a named co-inventor of the above-mentioned application. Moreover, the assignee of the '384 application at the time of filing, Anchor Gaming, was the assignee of the above-mentioned application at the time of filing. Further, the '384 application and the above-mentioned application were both transferred from Anchor Gaming to the present assignee, IGT. However, neither the author

of the July 1 amendment nor his firm prepared the above-mentioned application or the '384 application, and the author did not become aware of a relationship between the disclosure of the '384 application and the disclosure of the above-mentioned application until he reviewed Office Actions issued in regard to the '384 application and this application.

The author further noted the following. The '328 patent is presently assigned to IGT. However, the author did not become aware of a relationship between the disclosure of the '328 patent and the disclosure of the above-mentioned application until recently, when he reviewed the Office Action issued in regard to this application.

If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. Further, if there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Dated: December 17, 2004

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 4-6. The line weight and lettering of the Figs. 4 and 5 have been amended, and explanatory text (“Display Element,” “Second Display Element”) has been added to Boxes 118, 120, and 122 of Fig. 6.

Attachment: Three (3) replacement sheets